

Appln No.: 10/625,355
Amendment Dated: July 14, 2005
Reply to Office Action of January 14, 2005

REMARKS/ARGUMENTS

This is in response to the Office Action mailed January 14, 2005 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Applicants request a three month extension of time for response and enclose the fee. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 15-0610.

Claims 1-8 have been canceled without prejudice.

Claims 18, 26-28 and 34 have been amended in view of the rejection under 35 USC § 112, second paragraph. These amendment are believed to overcome the rejection. Claims 41-44 have been amended in view of the fact that claim 30 to which they refer is a method claim.

Independent claims 9 and 20 having been amended to specify that both the polycarbonate and the polyester are aromatic. This amendment is supported at ¶ 33, which indicates that suitable polyesters include aromatic dicarboxylic acids. Claims 9 and 20 have also been amended to indicate that the processing is done in a one step reactive extrusion process, i.e., one in which the listed processes proceed in a continuous manner without, for example, cooling the mixture and the remelting at a later time for continued processing, and that the catalyst is used in a small amount of 50 to 300ppm. This amendment is supported, *inter alia*, in ¶ 7, and ¶ 40. Claims 13, 26-28 and 36, which were inconsistent with this amendment have been canceled. Claims 45 and 46 which recite the specific catalysts from ¶ 74 have been added.

The Examiner rejected claims 1-44 as anticipated by or obvious over EP 736558. Applicants respectfully traverse this rejection as applied to the amended claims. The present invention claims a narrow and preferred range of amount for the transesterification catalyst. This amount is enough to provide both a single Tg and a transparent product with low yellowness. While this range fall within the broad range disclosed in EP 736 558, this range is so broad (0.000005-1 parts by weight, page 3) as to effectively provide no disclosure or suggestion of the preferred range now being claimed. Page 7 of EP 736558 discloses a broad range for Lewis Acid catalysts that partially overlaps with the now claimed range, and a preferred range which does not overlap. Further, the type and amount of catalyst used in the specific examples of the reference is not even disclosed. What is significant as far as EP 736 558 is concerned is the presence of terminal hydroxy groups or the addition of the acid quencher. Thus, consistent with the guidance given by MPEP §§ 2131.03 and 2144.05, EP 736 558 does not anticipate the presently claimed invention. It is further noted that EP 736558 teaches that a two step process, with two kneading steps is preferred. (Page 7, lines 10-12)

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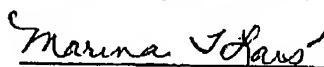
The Examiner also rejected claims 9-35 and 37-44 as anticipated by or obvious over EP 774491. In EP 774491 the disclosure of the amount of catalyst used is substantially equivalent to that in EP 736558 discussed above (See Page 8, lines 9-14). In the examples, specific catalysts are used in concentrations within the scope of the present invention. However, the procedure employed as described on Page 10 does not meet the limitations of the present claims. As described in EP 774491, all of the components are added together and blended together and then kneaded. This type of processing is discussed in the examples of the present application. Thus, there is no disclosure of specific examples with down stream addition of the acidic stabilizing agent as now claimed. Applicants further note that no information is provided in EP 774491 as to whether a single glass transition temperature was observed for samples 3 and 8, which include specific catalysts listed in claims 45 and 46.

The Examiner also rejected claims 9-12, 14-24, 26-32, 34, 35, 37 as anticipated by or obvious over US Patent No. 5,055,531. The Fox patent discloses a two step process, in which the acid quencher is added in a separate extrusion step. Furthermore, the catalysts range does not overlap with the catalyst range now claimed. Thus, the present claims are not anticipated by Fox et al.

It is noted that the Examiner has stated that "any combination of catalysts, stabilizers and amounts thereof within the disclosure would be obvious if not considered anticipatory" but has not with respect to any of the three references set forth the elements of an obviousness rejection. More is required to present a prima facie case of obviousness than an assertion of this type. In this case, the Examples show that certain catalysts (i.e., those now listed in claims 45 and 46) provide a single Tg at much lower levels than others. Since decreased catalyst level is desirable to provide better optical properties, the selection of these catalysts, and the use of the catalysts at the low levels set forth in the claims cannot simply be dismissed as the Examiner has done. Thus, if the obviousness rejection is maintained, Applicants submit that it should be properly presented in a non-final office action.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



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Enclosures: request for Extension of Time/ Credit Card Form